

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Shea, et al.

SERIAL NO.: 10/083,093

FILED: February 26, 2002

FOR: **LOCKING SYSTEM FOR IMPLANTS**

CONFIRMATION 5422

NO.:

GROUP ART 3733

UNIT:

EXAMINER: Ramana, A.

CERTIFICATE OF ELECTRONIC FILING

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Attorney Docket No.: 10557/266546

Date: November 17, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Responsive to the Final Office Action dated September 17, 2008 ("Final Action"), and in conjunction with the Notice of Appeal filed herewith, the Assignee respectfully submits this Request for Review in connection with this application and in accordance with OG Notice of 12 July 2005. A concise statement setting forth the reasons for the request is set forth below.

REASONS FOR THE REQUEST

Claims 47-58 are pending. The Final Action fails to establish a *prima facie* basis for rejecting pending claims 47-50 and 56-58 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,156,625 to Marchetti et al. (hereinafter "Marchetti"), and for rejecting claims 47-52 and 55-58 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,645,606 to Oehy et al. (hereinafter "Oehy"). In response to an April 15, 2008 Final Office Action that applied these same two references, the Assignee on July 15, 2008 filed a Request for Continued Examination and an Amendment and Response that amended the claims to place them in a better form for appeal, and also pointed to specific reasons why the Final Action did not present a *prima facie*

basis for rejecting the claims. The present Final Action nevertheless maintains the same rejections without providing sufficient information or otherwise showing how the references disclose each and every claim limitation. The Assignee respectfully requests review of the improper rejections in view of the Remarks set forth below and previous arguments by the Assignee, as provided for in OG Notice of 12 July 2005.

REMARKS

Marchetti

Page 1 of the Final Action rejects claims 47-50, 52, and 56-58 under 35 U.S.C. § 102(b) as anticipated by Marchetti.

Independent claims 47, 56, and 57 define an implantable prosthesis comprising a prosthesis component having at least two openings and an insertion member, where the openings can interchangeably receive both (1) a screw that is implanted in the bone, and (2) either a peg or a cover. The claims require that: (1) regardless of which insertion member is used, the insertion member be locked within the opening at one of a plurality of angles relative to the opening so that the insertion member and the prosthesis form a rigid physical construct; (2) the locking relationship must be formed between the opening and either the peg or the cover using only a taper in a frustoconical taper section of the opening and a surface of the peg or cover; (3) the contact between the insertion member and the opening form a substantially fluid tight seal; and (4) the head of the insertion member not contact a lower portion of the opening.

For a reference to anticipate a claim under § 102, it must describe, either expressly or inherently, each and every element set forth in the claim. MPEP § 2131. The Final Action ignores that Marchetti fails to disclose a number of limitations in the rejected claims. First,

Marchetti fails to disclose an opening having a non-threaded frustoconical taper section. (*See* Amendment and Response filed July 15, 2008, p. 10.) Second, Marchetti fails to show a structure whereby the insertion member may be inserted into the opening and locked in one of a plurality of angles to form a rigid physical construct at each of the angles. (*See id.*) Third, Marchetti fails to disclose a substantially fluid tight seal formed between the opening and the head of the insertion member, as required by claims 47-55. Finally, Marchetti fails to disclose that the opening of the prosthesis may interchangeably receive both a screw and either a peg or a cover, wherein a locking relationship is formed between the peg or the cover using only a taper in the frustoconical taper section and a surface of the peg or the cover, as required by claims 47-55. In fact, Marchetti only discloses the use of screws within the holes of the prosthesis, and does not contemplate the use of covers or pegs.

Accordingly, the Final Action fails to establish a *prima facie* basis for anticipation based on Marchetti for at least these reasons.

Oehy

The Final Action also rejects claims 47-52 and 55-58 under 35 U.S.C. § 102(b) as anticipated by Oehy. As shown at pages 11-13 of the Amendment and Response filed July 15, 2008, Oehy discloses a shell having conventional “for screw only” holes that accept either a fastening element or a closure plug. As also shown at pages 11-14 of the July 15, 2008 Amendment and Response, the previous Final Office Action failed to show how Oehy discloses numerous limitations of the pending claims. The current Final Action fails to add any new facts or analysis and the same omissions in Oehy continue to exist.

First, Oehy fails to disclose a non-frustoconical contact surface of the head of the insertion member that contacts the frustoconical contact taper section of the opening of the prosthetic component, as required by claims 47-52 and 55-58. (*See* Amendment and Response filed July 15, 2008, pp. 11-12.) Instead, as acknowledged at page 4 of the Final Action, Oehy discloses that the fastening element 14 is seatable on the concave support surface 25a, or non-frustoconical section as illustrated in the Examiner's annotated figure, of the opening. (*Id.*)

Second, Oehy fails to disclose a head of an insertion member that is locked within an opening and that does not contact a lower portion of the opening, as required by claim 47. Rather, as shown above and acknowledged at page 4 of the Final Action, the fastening element of Oehy sits within the rounded, non-frustoconical section 25a, not the frustoconical taper section (identified as reference numeral 25 in the Final Action), as required by this claim limitation. (*Id.* at 12.)

Third, Oehy fails to disclose that the openings of the prosthetic component interchangeably receive a screw having a threaded portion that allows the screw to be firmly implanted into the bone, as well as a peg or a cover, where a locking relationship between the peg or the cover and the opening is formed using only a taper in the frustoconical taper section and a surface of the peg or the cover, and where the insertion member is locked in one of a plurality of angles to form a rigid physical construct at each of the angles. (*Id.* at 12-14.) Indeed, as shown in the July 15, 2008 Amendment and Response, Oehy discloses a conventional "for-screw only" type hole that (a) does not lock the screw in place to form a rigid physical construct at each of a plurality of angles, (b) is not adapted to receive a peg, and (c) does not

receive a cover at one of a plurality of angles within the opening to form a rigid physical construct at each of the angles, as required by all of the pending claims. (*Id.* at 13-14.)

Fourth, Oehy fails to disclose that any locking relationship between its opening and the closure plug 15 is formed using only a taper of a frustoconoical taper section and a surface of the closure plug, a limitation present in all of the pending claims. (*Id.* at 15-16.) Instead, Oehy only shows that the closure plug is secured within the opening using flexible springs and a hat-like projection. (*Id.*)

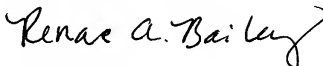
Finally, Oehy fails to disclose that the contact between the screw or closure plug of Oehy and the opening forms a substantially fluid tight seal, as required by claims 47-55.

Accordingly, the Final Action fails to establish a *prima facie* basis for anticipation based on Oehy, for at least these reasons.

CONCLUSION

For the reasons above, Applicants respectfully request allowance of the pending claims.

Respectfully submitted,



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